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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,620	10/28/2003	John D. Unsworth		2635

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EXAMINER

WELCH, GARY L

ART UNIT

PAPER NUMBER

3765

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/694,620

Applicant(s)

UNSWORTH ET AL.

Examiner

Gary L. Welch

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10282003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "4" has been used to designate both "rolling-up" (page 7, line 16) and "coil" (page 13, line 20). Additionally, reference character "8" has been used to designate both "socks" (page 12, line 12) and "foot" (page 14, line 15). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities:

Lines 4 and 9: Change "Allow" to --Alloy--

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3765

4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 requires the "springy elements" to be attached, connected or incorporated to the flexible tubular element (lines 1 and 2). How and by what means are the springy elements attached, connected or incorporated to the flexible tubular element? Are they connected internally or externally to the tubular element and are they glued, sewn or attached by other means to the tubular element?

Claim 1 requires the springy element to be fabricated from metal, plastic, superlastic nickel-titanium, or other springy material or Shape Memory Alloy (SMA) or other material that exhibits shape recovery or compositions thereof (lines 3-5). The examiner does not believe all plastics and metals are springy. What types of plastic or metal are springy and what degree of springy is required? Does the physical dimensions affect the amount of springy (i.e., long in the longitudinal dimension and very thin, etc)? What is meant by superlastic nickel-titanium? The recitation "other springy" is indefinite since it does not specifically define the metes and bounds of the patent protection sought. What materials are Shape Memory Alloys? Is the terminology Shape Memory Alloys known to be a certain type of material(s)? It appears that the specification is silent with respect to these materials and appear to be different than the metal, plastic and superlastic nickel-titanium.

Art Unit: 3765

Claim 1 requires the tubular element to be heated from the loaded martensitic phase to its unloaded austenitic state (lines 25-28). How and by what means (i.e., structure) enables this function to occur?

Claims 2 and 3 recite similar phraseology as above.

Claims 4-20 depend from one or more of the above rejected claims and are therefore rejected accordingly under 35 U.S.C. 112, second paragraph.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2-6, 8, 9, 11, 12, 15-17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Piotti (U.S. 5,606,982).

Piotti discloses a device comprised of a flexible tubular element (b) and one springy element (a) that are connected together. The springy element (a) is fabricated from plastic (Col. 2, lines 41-44). The flexible tubular element (b) is rolled upon the springy element (a) and the flexible tubular element if “unrolled” upon a body part (c). Restraining means (4) is provided at the distal outside end of the tubular element and restrains the loaded rolled-up tubular element from unrolling prior to being detached. The body part (c) is inserted within the device. The claimed structure limitations are disclosed by Piotti. The functional

recitations recited in the claim is purely functional and do not offer any structure that defines over the prior art.

With regard to claim 2, the invention is disclosed above.

With regard to claims 4 and 15, the claim does not offer any structure that further defines the device. Therefore, the claim is rejected as recited in the rejection to claim 1.

With regard to claims 5 and 16, the restraining means (4) of Piotti is considered a similar detachable attaching device.

With regard to claims 6, 8, 17 and 19, the base of the element (b) is considered a ring.

With regard to claims 9 and 20, the tubular element is a condom.

With regard to claim 11, the springy element (a) is hollow. When the tubular element (b) is placed over top the element (a) an air space is created (Figures 1, 2 and 3) having ambient air pressure.

With regard to claim 12, the invention is disclosed in one or more of the above rejected claims.

***Allowable Subject Matter***

7. Claims 7, 10, 13, 14 and 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

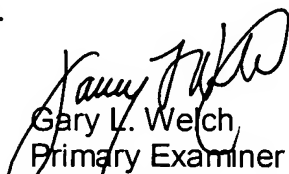
**Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zicarelli '453, Barton '520, Nishizono '463, Broad, Jr. '850, Lusk '071 and '289, Alla et al. '308 and Van Rensburg '018 disclose various article donning devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary L. Welch whose telephone number is (571) 272-4996. The examiner can normally be reached on Mon-Fri 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J. Calvert can be reached on (571) 272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gary L. Welch  
Primary Examiner  
Art Unit 3765

glw